PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Samuel T. Barone, Jr., et al.
Application No.	:	09/840,497
Filed	:	April 23, 2001
Title	:	SYSTEM AND METHOD FOR MERGING INTERACTIVE TELEVISION DATA WITH CLOSED CAPTION DATA

Confirmation No. 4459

Grp./Div.	:	2611
Examiner	:	Harun M. Yimam
Docket No.	:	42244/G476

REPLY BRIEF

Mail Stop Appeal Brief-Patents
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Applicant submits this brief in response to the Examiner's Answer mailed August 11, 2006. In the Examiner's Answer, the Examiner maintains his rejection of claims 1-28 under 35 U.S.C. § 103(a). Claims 29-30, however, are allowed.

1.   Bertram Does Not Remove NULL Packets to Create a Gap

In the Examiner's Answer, the Examiner continues to maintain that Bertram teaches a "processing unit . . . characterized in that the processing unit <u>creates a gap</u> in the first data stream for inserting a portion of data carried by the second data stream." (Emphasis added). The Examiner contends that "Bertram clearly teaches the creation of a gap in the first data stream (T_{IN1}) for inserting at least a portion of data carried by the second data stream (T_{IN2})." (Answer p. 15). In doing so, he reasons that in Bertram, a NULL packet is "<u>removed</u> thereby creating the

needed gap to insert data carried by the second data stream," that is, to insert the replacement packet instead of the NULL packet. (Id.) (Emphasis added).

Contrary to the Examiner's assertions, however, Bertram's transport multiplexer does not actually remove any NULL packets to create gaps in the first data stream (T_{IN1}) and actually fill the gaps in the first data stream (T_{IN1}) with replacement packets. That is not how multiplexers work. Instead, as Bertram explains, the "transport multiplexer 470 receives and examines each packet of the input transport stream T_{IN}. If a received packet is not a NULL packet, then the received packet is coupled to an output as part of an output transport stream T_{OUT}." (Bertram, 0038) (Emphasis added). Based on this disclosure, it is clear that if a received packet is a NULL packet and there is a replacement packet is waiting to be inserted into the output stream, the transport stream multiplexer couples the replacement packet to the output as part of the output transport stream. Thus, either an input packet from T_{IN} or a replacement packet waiting for insertion is selected to generate the output stream. The transport multiplexer, however, does not generate any gaps in the input stream T_{IN} and does not insert any replacement packet into these gaps.

2.   There is No Motivation to Combine Bertram and Feinleib

The Examiner contends that the combination of Bertram and Feinleib is proper in rejecting claims 1-11 and 17-23 because Feinleib recites various benefits of utilizing enhancing content to enhance a particular television program. (Answer, p. 16). Even if the Examiner were correct that a person of skill in the art would recognize the benefits of supplementing Bertram's programs with enhancing content, this is not evidence that a person of skill in the art would have been motivated to change Bertram's system in a manner that would cause it to read on the rejected claims. That is, to change Bertram's system so that instead of multiplexing different television programs to form a slotted MPEG transport stream, different substreams of the same television program (e.g. a closed caption data substream and an interactive data substream) would be multiplexed together to form the slotted MPEG transport stream. Simply recognizing the desirability of adding enhancing content to a television program is not sufficient motivation to make such a modification.

3.   The Combination of Bauchot and Bertram is Improper

The Examiner continues to maintain the rejection of claims 12 and 24 as obvious over Bertram in view of Bauchot, and continues to maintain that Bauchot is in the field of applicant's endeavor. (Answer, p. 16-17). The Examiner describes the field of applicant's endeavor to be the "field of transmitting information from one point to another." (Answer, p. 17). Applicant respectfully maintains that Bauchot cannot be deemed to be in Applicant's field of endeavor merely because both Applicant and Bauchot transmit information from one point to another. Common sense dictates against it. As the court In re Oetiker put it, we need to "consider 'the reality of the circumstances ' . . . -- in other words, common sense -- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor." 977 F.2d 1443, 1446 (Fed. Cir. 1992) (citing In re Wood, 599 F.2d 1032, 1036 (CCPA 1979). In considering such reality, and giving heed to common sense, the court in In re Clay concluded that a particular prior art reference could not be "considered to be within [Applicant's] field of endeavor merely because both related to the petroleum industry." 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). In a similar manner, applicant and Bauchot cannot be deemed to be in the same field of endeavor merely because they both transmit information from one point to another.

In his Answer, the Examiner continues to maintain that Bauchot was introduced simply to "teach manipulation data units assigned to particular time slots in data streams," and concludes that such "manipulation" includes all of those limitations in claim 12 which are not found in Bertram. However, the Examiner cannot read into a simple disclosure of manipulating data units assigned to particular time slots to necessarily require "identifying time slots identifying time slots of a television signal assigned to the plurality of first data units in the first data stream; reassigning a portion of the plurality of first data units assigned to particular time slots to earlier time slots; and assigning at least a portion of the plurality of second data units in the second data stream to the particular time slots," as is required in claim 12.

4. Conclusion

For these reasons, rejected claims 1-28 are patentable over the art of record, and the Examiner's rejection of those claims should be reversed.

Respectfully submitted,

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